



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/481,990	01/11/00	LESAGE	F 989.6351DIV

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EXAMINER

TEDESCHI, B

ART UNIT

PAPER NUMBER

1642

4

DATE MAILED:

12/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/481,990

Applicant(s)

LESAGE ET AL.

Examiner

Bruce W. Tedeschi

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1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Election/Restrictions

*Prior to setting forth the restriction, it is noted that claims 68-79 submitted in the preliminary amendment, filed with this application, have been renumbered 15-26 pursuant to 37CFR1.126.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 10 drawn to nucleic acid encoding animal protein, vectors, host cells and methods of use thereof classified in class 536, subclass 23.5.
- II. Claims 11-13 drawn to proteins, classified in class 530, subclass 350.
- III. Claims 9, 15-19 drawn to method of screening using proteins expressed on transformed cell, classified in class 435, subclass 7.1.
- IV. Claim 14 drawn to antibodies, classified in class 424, subclass 130.1.
- V. Claims 20-26 drawn to substance assayed by screening, classified in class 435, subclass 320.1.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the protein product as claimed can be made by another and materially different process, such as peptide synthesis isolation by conventional purification techniques from nature.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein product as claimed can be used in a materially different process of using that product; for instance, the potassium channel protein could be used as an immunogen to make an antibody.

Inventions III and V are related as process of use and product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case if the pharmaceutical substance activates the specific potassium protein channel protein as claimed then it could also modulate other specific cellular events, either indirectly through the potassium channel or directly by interacting with other cellular components.

Groups I, II, IV and V are directed to separate and distinct products. The products are distinct each from the other because they are structurally and functionally distinct. For example, group I is directed to a nucleic acid and its cloning into cells via vector; Group II is directed to a cellular membrane protein made by the cloned nucleic acid insert; Group IV is directed to antibodies which recognize and bind the cellular protein;

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and Group V is directed to any substance which modulates the activity of the cellular protein.

Groups I and III are related as methods. The methods are distinct because they have different goals, as evidenced by their preambles, different method steps (i.e. method for synthesis v. method for screening), and utilize different reagents (i.e. molecular biological chemicals v. electrophysiological probes).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Gerard J. Weiser on 10/20/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce W. Tedeschi whose telephone number is 703-3064823. The examiner can normally be reached on Monday - Friday, 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-3059876. The fax phone numbers for the organization where this application or proceeding is assigned are 703-3053230 for regular communications and 703-3053230 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-3059876.

BT

December 4, 2000

Patricia A. Duffy
PATRICIA A. DUFFY
PRIMARY EXAMINER